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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,164	11/19/2003	Paul R. Goth	155694-0125	8958

1622 7590 12/27/2005

IRELL & MANELLA LLP
840 NEWPORT CENTER DRIVE
SUITE 400
NEWPORT BEACH, CA 92660

EXAMINER	
PEFFLEY, MICHAEL F	
ART UNIT	**PAPER NUMBER**
3739	

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/718,164	GOTH ET AL.	
	Examiner	Art Unit	
	Michael Peffley	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Oct 7, 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's amendments and arguments, filed October 7, 2005, have been fully considered by the examiner. In particular, applicant's amendments have obviated the 35 USC 112 and 35 USC 101 rejections, as well as the objection to the Abstract. The following is a complete response to the October 7, 2005 communication.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hood et al (6,213,997) in view of the teaching of Strul et al (5,540,681).

Hood et al disclose an RF generator and electrode device for treating the cornea substantially as set forth in applicant's disclosure. In particular, it is noted that the Hood et al system is performing the same procedure and includes the same electrode structure as applicant's disclosed invention. Further, Hood et al disclose the same power levels and treatment times as set forth in applicant's disclosed invention. The only feature not expressly taught by Hood et al is the use of a circuit which is designed to provide an actual power curve to tissue that is within +/- 10% of the desired power curve.

The examiner maintains that it is generally very well known in the RF surgical field to monitor generator output and provide feedback to maintain the output parameters within a desired range. Strul et al disclose one such system that operates

by monitoring temperature and/or actual output power and controlling the delivery of RF energy accordingly.. In particular, Strul et al teach that the actual power delivered by the system is monitored and compared with the desired output profile, and feedback is provided to maintain the actual power as close as possible to the desired power (see col. 2, line 63 through col. 3, line 60 and col. 6, lines 1-20 and columns 9-10). While Strul et al do not disclose the specific percent range in which the actual and desired power is maintained, the examiner maintains that one of ordinary skill in the art would obviously look to minimize the discrepancy and would be capable maintaining such a range.

To have provided the Hood et al system with a circuit to monitor actual power delivered and provide feedback to maintain the actual power delivered within a close range of the desired power would have been an obvious consideration for one of ordinary skill in the art, particularly since Strul et al teach that it is known to provide RF generators with such a power feedback circuit.

Response to Arguments

Applicant's arguments filed October 7, 2005 have been fully considered but they are not persuasive.

Applicant asserts that the Strul reference does not disclose a circuit that is pre-calibrated to provide the recited limitations and that the Strul system requires a feedback system to regulate the power. The examiner notes that there is nothing in the claim language requiring any pre-calibration of the circuit, nor is there anything in the current claim language that would preclude the use of a feedback system to arrive at a

desired power curve within an acceptable error range. Strul teaches that it is known to use feedback (i.e. a cirucuit) to maintain a desired power curve when treating tissue. The examiner maintains that this power curve would be maintained over a range of tissue impedances, particularly when operating in a mode of constant power. The only feature not expressly taught by Strul is the particular variance between the actual and desired power curves. The examiner maintains that electrosurgical systems would generally be calibrated to maintain desired actual parameters well within =/- 10% of a desired value, as is generally known in the art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wham et al (6,796,981) disclose an electrosurgical system that delivers a desired power curve to tissue dependent on the tissue impedance (see Figure 1a and Figure 1b).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Peffley
Primary Examiner
Art Unit 3739

mp
December 22, 2005